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PAOLETTI, ET AL.

v.

MOSS, ET AL.

Administrative Patent Judge  
Andrew H. Metz

THOMAS J. KOWALSKI, REG. NO. 32,147  
Name of Applicant, Assignee or Registered Representative  
*Thomas J. Kowalski*  
Signature  
13 Mar 95  
Date of Signature

PAOLETTI ET AL. MOTION UNDER 37 C.F.R. §1.633(c)(4)  
TO DESIGNATE PATENT CLAIM AS NOT CORRESPONDING TO THE COUNT

Sir:

VIRO\5010(SL).NCC

of Moss et al. application Serial No. 07/987,546, filed December 7, 1992 ("Moss"), without any prejudice or admission with respect to any other Motion, position, assertion or argument by Paoletti now or in the future.

FACTS

The '112 Patent issued July 29, 1986 from U.S. application Serial No. 446,824, filed December 8, 1982, as a continuation-in-part of application Serial No. 334,456, filed December 24, 1981, now U.S. Patent No. 4,769,330 ("the '330 Patent") (a copy of the '112 Patent and the '330 Patent is attached as Exhibits 1 and 2).

The '112 Patent issued with two independent claims (claims 1 and 12). Claim 12 is directed to a particular culture of a vaccinia virus and is not pertinent to the discussion herein. Claim 1 is directed to the generic invention first disclosed and fully enabled in the '330 Patent, namely,

1. A recombinant vaccinia virus synthetically modified by the presence, in a non-essential region of the vaccinia genome, of DNA not naturally occurring in vaccinia virus.

Claim 2 of the '112 Patent is directed to a sub-genus of claim 1, namely, vaccinia virus of claim 1 wherein the DNA is expressed by the production of a protein. Claim 7 involved in the Interference is a Markush-type claim (using alternative

language, i.e., "or") of particular species of the recombinant vaccinia virus of claim 1, namely,

7. A vaccinia virus as in claim 1 which is vaccinia virus VP-2, VP-3, VP-4, VP-5, VP-6, VP-7, VP-8, VP-9, VP-10, VP-11, VP-12, VP-13, VP-14, VP-16, VP-17, VP-18, or VP-22.

Certain species within Paoletti '112 Patent claim 7 are not within Moss' claims (as best they can be understood). For example, vP3 and vP5 are within the genus of claim 1 but not the sub-genus of claim 2.

More particularly, Moss claims 33, 44, 55 and 57 are independent claims. Moss claims 33, 36, 37, 39, 41, 42 and 43 are directed to a plasmid. Moss claims 44, 47, 48, 50, 52, 53, and 54 are directed to a recombinant vaccinia virus Moss claims 55 and 56 are directed to a method for preparing a vector, and, Moss claim 57 is directed to a method for producing a protein. A copy of Moss claims 33, 36, 37, 39, 41, 42, 43, 44, 47, 48, 50, 52, 53, 54, 55, 56 and 57 is attached as Exhibit 3. Moss claims 33 and 44 are not limited by the method of claims 55 or 56, and Moss Claim 44 is not limited to a plasmid of claim 33, or, such a plasmid prepared by a method of Moss claims 55 or 56.

All of the Moss claims include the term "adjacent to" and this recitation was relied upon in an attempt to distinguish over the '330 Patent, as shown by pages 11 to 13 of the June 18, 1990 Preliminary Amendment in USSN 07/539,169, pages 10 to 17 of the March 2, 1992 Amendment in USSN 07/539,169, pages 2 to 3 of

the June 24, 1993 Office Action in USSN 07/987,546, and pages 2 to 4 of the October 22, 1993 Amendment in USSN 07/987,546, copies of which pages are attached as Exhibit 4 (compare the admissions regarding the state of the promoter art by Moss on pages 12 to 15 of the Preliminary Amendment in USSN 07/987,546 and page 9 of the Preliminary Amendment of USSN 07/539,169, a copy of which pages is attached as Exhibit 5).

That is, Moss has consistently argued that there is a distinction between what Moss claims and the generic and sub-generic inventions of Paoletti claims 1 and 2, particularly certain exemplified species thereof (vP2, vP4 and vP6) of claim 7. As best as Paoletti can determine from Moss' position in a European Opposition to Moss' corresponding European application and patent, Moss may believe that Paoletti's vP22, one sole species included in Paoletti's claim 7, is within what Moss claims.<sup>1</sup> However, claim 7, by including numerous species which

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<sup>1</sup> See Exhibit 6, a copy of the Moss European application and patent in Opposition, Virogenetics Corporation's Opposition and Moss' August 22, 1994 response to the Opposition. But see Exhibit 4, page 13 of June 18, 1990 Preliminary Amendment of USSN 539,169 wherein Moss asserts that EPA 0 083 286, the published European application corresponding to the '112 Patent (and having, as filed, the same specification thereof), "would not have ... enabled a recombinant poxvirus construct in which polypeptide encoding DNA sequence foreign to poxvirus was adjacent to and under transcriptional control of a poxvirus TRS." Thus, either Moss may have changed their position from June 18, 1990 and not called the same to the attention of the U.S. PTO, perhaps contrary to 37 C.F.R. §1.56, or Moss has asserted and maintains before the PTO that the exemplified species of the '112 Patent are distinct, patentably, from whatever Moss is claiming.

Moss has asserted to be distinct from, can be broader than and distinct from the Count.<sup>2</sup>

Therefore, despite the provisions of 37 C.F.R. §1.606 that, "[a]t the time an interference is initially declared, a Count shall not be narrower in scope than any patent claim which corresponds to the Count," the Count, Moss claim 44, in the present Interference is narrower than '112 Patent claim 7, which has been designated as corresponding to the Count.<sup>3</sup>

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<sup>2</sup> Without prejudice or admission, it is believed that under the Moss patentability argument, Moss Claim 44, the Count, is a sub-sub-genus of Paoletti '112 Patent Claim 1, and a sub-genus of Paoletti '112 Patent Claim 2 (which calls for the vaccinia virus of '112 Patent Claim 1 wherein the DNA is expressed in a host by the production of a protein) such that Paoletti '112 Patent Claim 7, by including species within the genus and sub-genus of '112 Patent claims 1 and 2 not within Moss' sub-sub-genus, is likewise broader than Moss claim 44 and the Count. Indeed, from Moss' prosecution (see, e.g., Exhibit 4), Moss has at least implicitly admitted that Paoletti is the inventor of the genus and sub-genus of Paoletti '112 Patent claims 1 and 2, by consistently attempting to distinguish therefrom and, by never asserting that Moss was claiming the same invention thereof or, had the right to so do; for instance, Moss never attempted to claim or assert to be claiming the same as Paoletti claims 1 and 2, despite the passage of more than a year from the issuance of the '112 Patent. Moss never attempted to provoke an Interference with either of the '330 or '112 Patents.

<sup>3</sup> In a pending application, Paoletti presents sub-sub-genus claims and, species claims. By concurrently filed Motions, Paoletti respectfully requests that the pending application and claims thereof be added to the Interference, that Paoletti be accorded the benefit of earlier applications, including USSN 334,456, that the Count be substituted with Paoletti's sub-sub-genus claim, and that the Interference be redeclared with Paoletti as Senior Party. Granting those Motions dovetails with granting this Motion (and designating Paoletti '112 claim 7 as not corresponding to the Count and removing the Paoletti '112 Patent from the Interference).

ARGUMENT

A species may be patentably distinct from a genus such that a first patent issues to one party with claims directed to the genus and, a second patent issues to another party with claims directed to the species. See, e.g., In re Baird, 29 USPQ 2d 1550 (Fed. Cir. 1994); In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir 1992); In re Taub, Wendler, and Slates, 146 U.S.P.Q. 384 (C.C.P.A. 1965); In re Petering, 133 U.S.P.Q. 275 (C.C.P.A. 1962); Hsing v. Myers, 2 U.S.P.Q.2d 1861 (BOPAI 1987).

The Commentary to Rules of Practice, 49 Fed. Reg. 48416, 48433 (Dec. 12, 1984), 1050 O.G. 395 (Jan. 29, 1985), corrected 50 Fed. Reg. 23122 (May 31, 1985), 1059 O.G. 27 (Oct. 22, 1985) provides in pertinent part:

Thus, if a species is patentable over a genus, the species is a "separate patentable invention" from the genus. Compare In re Taub, 348 F.2d 556, 146 USPQ 384 (C.C.P.A., 1965).

If Moss' sub-sub-genus claim 44 and independent claims 33, 55 and 57 of similar scope, and, the claims dependent thereon, are, for argument's sake, a "species" distinct from either of Paoletti '112 Patent genus and sub-genus claims 1 or 2 (which are fully supported, described and enabled in USSN 334,456),<sup>4</sup> then Paoletti claim 7, calling for species within

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<sup>4</sup> See Exhibit 4, particularly page 13 of the June 18, 1990 Preliminary Amendment of USSN 539,169, asserting distinction from disclosure of EPA 0 083 286, corresponding to that of the '112 Patent.

Paoletti '112 Patent claims 1 and 2 and not within Moss' claims is therefore broader than and likewise distinct from Moss claim 44 and all of Moss' claims. If, for argument's sake, vP22 is within the scope of all of Moss claim 44 (or any of other Moss' claims) and Paoletti Patent claims 1 and 2, then this is also therefore of no moment if Moss' claims are distinct from Paoletti '112 claims 1 and 2. In the scenario of a species patentably distinct from a genus, a singular species is also within the claims of the above-discussed first and second patents.

In this regard, attention is also directed to In re Sasse, 207 U.S.P.Q. 107 (CCPA 1980) wherein the Court of Customs and Patent Appeals held that a claim to a genus and a claim to a species within the genus are not claims to the same or substantially the same subject matter in the sense of 35 U.S.C. §135(b). If, for argument's sake, vP22 is the only species of those of Paoletti '112 Patent claim 7 within Moss' sub-sub-genus (but such is not necessarily admitted herein), and, due to Markush-style claiming, claim 7 is viewed, for purposes of the Interference, as a claim to only vP22 (although such is not believed proper since by listing alternative species, claim 7 is broader than a claim to an individual species),<sup>5</sup> then under

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<sup>5</sup> For instance, dependent, and therefore narrower claims from Paoletti '112 Patent Claim 7 could read: "The vaccinia virus of claim 7 which is vP22" or "The vaccinia virus of claim 7 which is vP2, vP4 or vP6." That is, dependent and therefore narrower claims from a Markush-style claim can recite singular items of the Markush group or, a subset of the Markush group.

Sasse, Paoletti and Moss are not claiming the same or substantially the same subject matter.

The requirements of 37 C.F.R. §§1.633(c)(4) and 1.637(c)(4) have been met. In particular, Paoletti identified claim 7 of the '112 patent as not corresponding to the Count and, has shown that claim 7 of the '112 patent can not define the same patentable invention as any other claim designated in the notice declaring the interference as corresponding to the Count.

Designating claim 7 of the '112 Patent as not corresponding to the Count due to the absence of an interference-in-fact between the claims of the Moss application and claim 7 of the '112 Patent is respectfully requested.



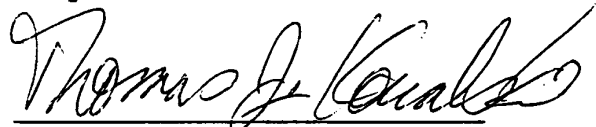
CONCLUSION

Upon the basis of the foregoing facts and law, claim 7 of Paoletti can be designated as not corresponding to the Count and, Paoletti respectfully requests this relief.

Respectfully submitted,

CURTIS, MORRIS & SAFFORD, P.C.  
Attorneys for Paoletti et al.

By:

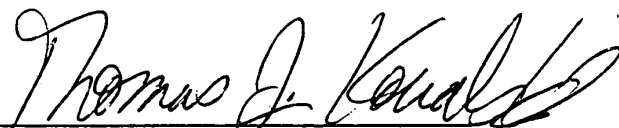


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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing PAOLETTI ET AL. MOTION UNDER 37 C.F.R. §1.633(c)(4) TO DESIGNATE PATENT CLAIM AS NOT CORRESPONDING TO THE COUNT is being served upon the party MOSS ET AL. on this 13th day of March, 1995 by posting said true copy by first class mail, postage prepaid to the lead attorney for MOSS ET AL. at his address of record, namely:

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